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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			DESAI, ANISH P	
			ART UNIT	PAPER NUMBER
			1794	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/743,864	NOJIRI, HIDEYUKI	
	Examiner	Art Unit	
	ANISH DESAI	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 February 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 39-58 is/are pending in the application.
- 4a) Of the above claim(s) 41,42,48,55 and 56 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 39,40,43-47,49-54,57 and 58 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

1. Applicant's arguments in response to the Office action dated 04/20/07 and 01/10/08 have been fully considered.
2. All of the previously pending claims 20-38 are cancelled. Claims 39-58 are new claims.
3. Applicant's election without traverse of species A (claims 40, 46, and 54) in the reply filled on 02/05/08 is acknowledged. Accordingly, claims 39, 40, 43-47, 49-54, 57, and 58 are examined. Claims 41, 42, 48, 55, and 56 are withdrawn.
4. The 35 USC Section 112-first paragraph rejection to claims 24-27 and the 35 USC Section 112-second paragraph rejection to claims 20-38 are moot, because these claims are cancelled. However, upon further consideration, a new 35 USC Section 112-first and second paragraph rejections are made.
5. The 35 USC Section 102(b) rejections to claims 20-23, 28-30, 33-36 based on Hodgson (US 3,645,835) is moot, because these claims are cancelled. However, a new 35 USC Section 103(a) rejection based on Hodgson (US 3,645,835) is made.
6. The 35 USC Section 102(b) rejection to claims 24-28, 31, and 32 based on Rollins et al. (US 5,340,648) is moot, because these claims are cancelled. Additionally, Rollins does not teach or suggest that the adhesive layer covers entirety of the first surface and the second surface as claimed in new independent claims 39, 45, and 51.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 39-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. For example regarding claims 39 it is not clear as to where is the support for the recitation "the first surface and the second surface each have a pair of side edges that consistently elongate...in an unstretched state, cross sections of the first surface and the second surface perpendicular to the longitudinal direction of the tape member each have a flat form...unstretched state, the cross sections each have a uniform form along...in the unstretched state" and "has resilient shrinkability larger than tension of skin on the eyelid" in the specification is provided. Similarly, regarding claims 44, 50, and 58 the specification fails to provide support for the recitation "a part configured to be removed after the double eyelid is formed".

9. Regarding claim 45, the specification fails to provide support for the recitation "the first surface and the second surface each have a pair of side edges that consistently elongate along the entire longitudinal direction of the string member...cross sections of the first surface and the second surface perpendicular to the longitudinal direction of the string member...when the string member is in the unstretched state" and "a resilient shrinkability larger than tension of skin on the eyelid".

10. With respect to claim 51, the specification fails to provide support for the recitation "the elongate member includes an adhering portion configured to adhere to the eyelid arranged in a manner sequential to the pair...elongate member" and "cross sections of the first surface and the second surface each have a uniform form...unstretched state".

11. Regarding claim 52, the specification fails to provide support for the recitation "the cross sections of the first surface and the second surface perpendicular...when the tape member is in the unstretched state".

12. Applicant has generally stated that the support for new claims is found for example page 7 lines 13 to page 20 line 21 and in the corresponding Figures. However, the cited portions and Figures fail to provide the support for certain claimed features. Applicant is respectfully reminded that in his/her response, he/she should clearly point out where exactly in the specification (including Figures) the support for any amendment is found.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 49 recites "string tape member", there is insufficient antecedent basis for the recitation of "string tape member". As such the Examiner suggests deletion of "tape" from the "string tape member".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 39, 40, 43, 44, 51-54, 57, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodgson (US 3,645,835).

15. With regards to claims 39 and 51, the recitations of "a double eyelid forming article of manufacture for forming a fold on an eyelid of a user", "configured to be adhered onto an eyelid in a stretched state along a longitudinal direction to form a double eyelid", and "the tape member in a state stretched along the longitudinal direction has a resilient shinkability larger than tension of skin on the eyelid...for forming a fold on the eyelid by adhering to the eyelid while the tape member is in the stretched state and subsequently recoiling back toward the unstretched state" are related to an intended use of the claimed article (i.e. tape member or string member). It is the Examiner's position that if the structure and composition of the prior art article is same as claimed by the Applicant's article, then the prior art article is capable of functioning the intended use as presently claimed. Thus, any reference disclosing a tape member that is resiliently stretchable (i.e. elastic) having "a first and second surface to elongate consistently along the entire longitudinal direction of the tape member while these surfaces are oppositely faced to each other", "the first surface and the second surface...pair of side edges that consistently elongate...the entire longitudinal direction

of the tape member", "the individual side edges of the first surface and the second surface...forms in parallel to each other "long the whole longitudinal direction...when the tape member is in an unstretched state, cross sections of the first surface...uniform form along the whole longitudinal direction...when the tape member is in the unstretched state...the first surface and the second surface each have an adhesive layer...entirety of the first surface and the second surface, the tape member has a consistent...along the entire longitudinal direction", will read on the claims.

16. Hodgson discloses adhesive materials for use on animal bodies especially human bodies for surgical, dermatological or cosmetic use. The examples include surgical drapes, adhesive dressings, strips and sheets, and eyeliners (Column 2. lines 74-75, Column 3. lines 1-5). Additionally, according to Hodgson another preferred use of the present invention is in surgical drapes. These are large flexible sheets, which are provided with a continuous layer of adhesive on at least a part only of one surface (column 7, lines 64-67). Further, at column 1 lines 25-30, Hodgson discloses "According to the present invention...a backing material having a pressure-sensitive adhesive on at least substantially the whole of the body-adhering portion of at least one surface of said backing material". This disclosure of applying the adhesive on at least one surface of the tape is interpreted as that adhesive layer can be applied on the both surfaces of the tape member, and it reads on the claim requirement of "the first surface and the second surface each have an adhesive layer covering an entirety of the first surface and the second surface".

17. Further, the adhesive drape of Hodgson as shown in Figure 7 has a backing layer 2 having an adhesive coating 4 on the surface of the backing layer. Further, the adhesive 4 is covered by a protector 6 (column 10, lines 27-31). The backing layer 2 of Hodgson is preferably formed of a polyurethane film (column 8, lines 5-6). At column 5, lines 69-74, Hodgson discloses Estane 5701 and 5702 brand thermoplastic polyurethane films, which is a polyurethane elastomeric film as evidenced by US 2007/0066185A1 to Felipe (paragraph 0058). Further, Hodgson teaches a use of elastic backing material (column 10, lines 38-39). The elastic backing layer 2 of Hodgson having an adhesive coating 4 is equated to a resiliently stretchable elongate tape member. Moreover, the adhesive tape member of Hodgson, as shown in Figure 7 has "the a first surface and a second surface" that "elongate consistently along the entire longitudinal direction of the tape member while these surfaces are oppositely faced to each other" and "the individual side edges of the first surface and the second surface are each in linear forms in parallel to each other along the whole longitudinal direction of the tape member when the tape member is in an unstretched state". Additionally, if one would to examine the cross-section of the adhesive tape member of Hodgson as shown in Figure 7, it would read on "cross sections of the first surface...is in the unstretched state, the cross sections each have uniform form along the whole longitudinal direction...is in the unstretched state".

18. Additionally, as to the claim requirement of "the elongate member includes a pair of holding portions configured to be held with fingers and arranged individually on a first end of the elongate member and a second end of the elongate member along the

longitudinal direction", Hodgson teaches that the two edges 24 of the backing material 2 are left uncoated (column 10, lines 31-32). Moreover, as to the claim requirement of "the elongate member includes an adhering portion", the claim does not explicitly exclude the adhering portion from being a part of the surfaces of the tape member, therefore a portion of the backing layer surface of Hodgson which is covered with an adhesive layer is equated to the "adhering portion".

19. With respect to the claim requirements of "the tape member in a state stretched along the longitudinal direction has a resilient shrinkability larger than a tension of skin on the eyelid and also has sufficient width and a sufficient length for forming the fold" and "the elongate member is configured to form the double fold by adhering to the eyelid where the elongate member...subsequently recoiling back toward the unstretched state", "the first end of the elongate member and the second end of the elongate member along the longitudinal direction of the...form a part configured to be removed after the double eyelid is formed". It is reasonable to presume that the adhesive tape member of Hodgson has the properties of "resilient shrinkability" and sufficient width and a sufficient length for forming the fold. Because as set forth above the adhesive tape members of Hodgson and that of Applicant have similar structure and composition. Therefore, the aforementioned features would be present. The burden is shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594). Moreover, as to the claim requirement of the arrangement of a release material on each of the adhesive layers on the first surface and the second surface. It is noted that Hodgson discloses of applying the adhesive on at least one surface of the backing

(column 1 lines 25-31) and covering the adhesive layer with a silicone-coated release paper (column 6 lines 70-73 and column 7 lines 70-71). Thus, it would have been obvious to provide an adhesive on the second surface of the backing and cover it with a release layer, motivated by the desire to protect the adhesive layer. As to the claim requirement of the elongate member being a string member and “cross sections...arcuate shapes...unstretched state”, it is noted that the invention of Hodgson is used in surgical drapes, suture strips...solid eye liners etc. (column 3 lines 1-5). Further, Hodgson discloses the size and the shape of the suture strips may of course be varied as desired (column 8 lines 44-53). Therefore, choosing a shape the tape member in the form of a string having outwardly protruding arcuate shapes involves routine skill in the art.

20. Claims 45, 46, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calvin (US 4, 653, 483).

21. With regards to the recitation “a double eyelid forming article of manufacture for forming a fold on an eyelid of a user”, “configured to adhere to the eyelid in...to form a double eyelid”, and “a resilient shrinkability larger than tension of skin on the eyelid...recoiling back toward the unstretched state” are related to an intended use of the claimed article (i.e. tape member or string member). It is the Examiner’s position that if the structure and composition of the prior art article is same as claimed by Applicant’s article, then the prior art article is capable of functioning the intended use as presently claimed. Thus any reference disclosing a string member that is resiliently

stretchable (i.e. elastic) having "a first and second surface to elongate consistently along the entire longitudinal direction of the tame member while these surfaces are oppositely faced to each other", "the first surface and the second surface...pair of side edges that consistently elongate...the entire longitudinal direction of the tape member", "the individual side edges of the first surface and the second surface...forms in parallel to each other "long the whole longitudinal direction...when the tape member is in an unstretched state, cross sections of the first surface...uniform form along the whole longitudinal direction...when the tape member is in the unstretched state...the first surface and the second surface each have an adhesive layer...entirety of the first surface and the second surface, the tape member has a consistent...along the entire longitudinal direction", will read on the claims.

22. Calvin discloses an adhesive tape having a backing and a layer of adhesive on each side of the adhesive tape (see abstract, Figure 15 and column 5 lines 1-5). As to the claim requirement of "string member", it is noted that Applicant has generally recited "a string member" but not provided any dimension (e.g. diameter, length etc.) of a string member nor defined what is meant by "string member". It is noted that Calvin's tape is applied to an eyelid to retain a fold in the skin thereof (column 1 lines 10-15). Further, Calvin discloses that "According to the present invention, a very thin strip of double-sided adhesive tape 32 generally **less than 1 cm in width** and 4 cm in length is attached to the upper eyelid 10 (column 3 lines 50-55). This disclosure of Calvin reads on a string member as claimed. Further, the backing film of Calvin is formed of polyethylene (see column 5 lines 39-45). It is noted that polyethylene is elastic as

evidenced by claim 10 of Burk (US 3,847,780). Thus, the polyethylene backing of Calvin reads on the resiliently stretchable elongate string member as required by the presently claimed invention. As to the claim requirements of "first surface and the second surface...oppositely faced to each other", "the first surface and the second surface each have a pair of side edges...of the string member", "the individual side edges are each in liner forms in parallel to each other...in an unstretched state", "cross sections of the first surface...outwardly protruding arcuate shapes...when the string member is in the unstretched state...the cross sections each have a uniform form along the whole...in the unstretched state", these limitations are disclosed in Figure 13 (e.g. arcuate shape of the cross section) and Figure 15 or obvious optimization to one of ordinary skill in the art, motivated by the desire to produce a string member that can suitably be applied to eyelids.

23. As to the claimed features of "the string member in a state stretched along the longitudinal direction has a resilient shrinkability larger than tension of skin on the eyelid and also has...recoiling back toward the unstretched state" and "a first end of the string member and a second end of the string member...a part configured to be removed after the double eyelid is formed", it is reasonable to presume that said requirement is present in the string member of Calvin. Support for said presumption is based on the fact that as stated above the string members of Calvin and that of Applicant are structurally and compositionally equivalent. Therefore, said claimed features would be present. The burden is shifted to Applicant to prove it otherwise (*In re Fitzgerald*, 205 USPQ 594). As to the claim requirement of the release material in a consistent and

integral form, it would have been obvious to provide a release material in consistent and integral form, motivated by the desire to protect the adhesive layers.

24. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Calvin (US 4,653,483) in view of Samuelsen et al. (WO 99/38929). US 6,482,491B1 to Samuelsen is relied upon for convenience.

25. The invention of Calvin is previously disclosed. Calvin is silent as to teaching the individual release materials each include an arcuate groove along a surface of each of the adhesive layers. However, Samuelsen discloses an article having a surface showing adhesive properties and a cover layer (release layer) for protecting the adhesive surface (abstract). Additionally, the release layer of Samuelsen has indentations in the forms of grooves, ridges, bulges, bumps etc. (column 2 lines 22-26 and column 4 lines 20-35). This disclosure of Samuelsen reads on the release material having an arcuate groove as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the release materials having arcuate groove, motivated by the desire to easily remove the release materials.

26. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Calvin (US 4,653,483) in view of Hodgson (US 3,645,835).

27. Calvin does not explicitly teach "a first end of string tape member and a second end of the string member...holding portions configured to be held with fingertips, and the holding portions have no adhesive property or have a suppressed adhesive property".

However, the invention of Hodgson is previously disclosed. Hodgson discloses that the two edges 24 of the backing material 2 are left uncoated (column 10, lines 31-32). The uncoated areas on the backing layer of Hodgson reads on a holding portion as claimed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide holding portion having no adhesive property such that the string member can be handled easily during its application to an eyelid by a user and such arrangement would prevent user accidentally touching the adhesive layer and potentially contaminating the adhesive.

Response to Arguments

28. Applicant's arguments filed on 10/19/07 have been fully considered but they are not persuasive.
29. Regarding the art rejections based on Hodgson (US 3,645,835), Applicant argues that Hodgson does not disclose or suggest "the first surface and the second surface each have an adhesive layer covering an entirety of the first surface and the second surface". The Examiner respectfully disagrees. It is respectfully submitted that Hodgson discloses that another preferred use of the present invention is in surgical drapes. These are large flexible sheets, which are provided with a continuous layer of adhesive on at least a part only of one surface (column 7, lines 64-67). Further, at column 1 lines 25-30, Hodgson discloses "According to the present invention...a backing material having a pressure-sensitive adhesive on at least substantially the whole of the body-adhering portion of at least one surface of said backing material". This is a clear indication that adhesive layer is applied on the both surfaces of the tape

member, and it reads on the claim requirement of "the first surface and the second surface each have an adhesive layer covering an entirety of the first surface and the second surface".

30. Applicant argues that Hodgson does not teach or suggest the elastic backing material has resilient shrinkability larger than tension of the skin on the eye lid or that the elastic backing material has a sufficient width and a sufficient length for forming a fold on the eyelid. The Examiner respectfully disagrees. It is noted that Applicant has not specified any material or composition that his/her tape member is made of or defined what is meant by "resilient shrikability". It appears from the specification that Applicant's tape member has elasticity such that it is stretchable. The backing of Hodgson's tape member is formed of elastic material such as polyurethane film (column 8, lines 5-6) such as Estane 5701 and 5702 brand thermoplastic polyurethane films. As shown previously the polyurethane films of Hodgson are elastic as evidenced by US 2007/0066185A1 to Felipe (paragraph 0058). Further, Hodgson teaches a use of elastic backing material (column 10, lines 38-39). Thus, to the Examiner the tape members of Hodgson and that of Applicant are made of the same elastic material. Therefore, the aforementioned features of resilient shrinkability would be present. As to the arguments regarding sufficient width and length, it is noted that the term "sufficient" is relative and Applicant has provided no guidance as to what is meant by "sufficient width" or "sufficient length". Therefore, the tape of Hodgson meets the claim requirements of "sufficient width" and "sufficient length" such that it can form a fold on the eyelid. Accordingly, the art rejections are maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hai Vo can be reached on 571-272-1485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./
Examiner, Art Unit 1794

/Hai Vo/
Hai Vo
Primary Examiner, Art Unit 1794